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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,119	07/17/2003	Carl-Magnus A. Andersson	ACADIA.011DV1	4466

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EXAMINER

CHANG, CELIA C

ART UNIT PAPER NUMBER

1625

DATE MAILED: 09/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/623,119

Applicant(s)

ANDERSSON ET AL.

Examiner

Celia Chang

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-76 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-76 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. This application is a divisional of 09/844,258. All claims stayed as originally filed. A restriction was issued in the parent case.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 9-12, 26-29 drawn to bicyclic of claim 9 compounds and their compositions, classified in class various, subclass various, depending on species election. Further election of a single disclosed species is also required and further restriction with respect to the elected species will be required.
- II. Claims 13-16, 30-33 drawn to bicyclic compounds of claim 13 compounds and their compositions, classified in class various, subclass various, depending on species election. Further election of a single disclosed species is also required and further restriction with respect to the elected species will be required.
- III. Claims 1-8, 17-25, drawn to remaining compounds and their compositions. not encompassed by groups I or II, classified in class various, subclass various, depending on species election. Further election of a single disclosed species is also required and further restriction with respect to the elected species will be required.
- IV. Claims 35-44 drawn to method of increasing muscarinic receptor activity, classified in class 514, subclass various depending on species election. If this group is elected, a further election of a single disclosed active compound for a single physiological/pathological condition for the method is also required. Further restriction will be made.
- V. Claims 45-55 drawn to method of agonistically affect muscarinic receptor activity, classified in class 514, subclass various depending on species election. If this group is elected, a further election of a single disclosed active compound for a single physiological/pathological condition for the method is also required. Further restriction will be made.

Art Unit: 1625

- VI. Claims 56-73 drawn to method of treating diseases, classified in class 514, subclass various depending on species election. If this group is elected, a further election of a single disclosed active compound for treating a single disease for the method is also required. Further restriction will be made.
- VII. Claims 73-76, drawn to method of identifying generic polymorphism, classified in class various, subclass various, depending on species election. If this group is elected a further election of a single disclosed compound for a single genetic polymorphism is also required. Further restriction will be made.

The inventions are distinct, each from the other because:

Groups I-III compounds differ in structure, chemical bonding and chemical property to such a degree that the search of each group is not co-extensive. Groups IV-VII, the method of using the compounds are unrelated i.e. disease and genetic polymorphism are not related. Therefore, separate searches and examination must be conducted.

It was further of record that factual evidence was made of record indicated that the core structure of formula I of claim 1 are patentably independent and distinct. It was noted that when the core is indolyl, such compounds have antihypertensive activity (see CA 64:67726); when the core is benzoxazolyl, such compounds have antipsychotic activity (see US 4,458,075, cited on 1449 of parent case); when the core is benzofuranyl, such compounds have GABA uptake inhibiting activity; when the core is benzothienyl, such compounds have dopamine transporter binding activity (see CA 126:69745 recited in parent case). Therefore, not only compounds having separate core structure need to be searched and examined separately, it is also evidenced that such compounds having independent and separate core structure each supports separate patent.

Therefore, based on the species election of example 19, the subject matter of claims 9-12 being drawn to indazolyl compounds are examined and issued into patent No. 6,627,645.

Applicant is advised that the reply to this requirement to be complete must include an election of the remaining invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the

Art Unit: 1625

currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang whose telephone number is 571-272-0679. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang, can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OACS/Chang
Sept. 28, 2005



Celia Chang
Primary Examiner
Art Unit 1625